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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,552	11/25/2003	Jean-Louis Gueret	NONY 3.0-015	5845
530 7590 04/22/2009 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER STEITZ, RACHEL RUNNING	
			ART UNIT 3732	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/721,552	Applicant(s) GUERET, JEAN-LOUIS	
	Examiner Rachel R. Steitz	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-32 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-32 and 34-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/24/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 24, 2009 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-26, 29-32, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anakama (Japanese Patent No. 55-136409) in view of Gueret (US 5,918,994) and Anderson (US 3,343,551).

Anakama discloses a device comprising a rod 2 having a brush 3 affixed to one end with a core and bristle carrying portion. The bristle carrying portion forms an angle of greater than zero degrees relative to the longitudinal axis of the rod. The device further includes a receptacle adapted to receive the rod and brush. As noted in the claims the brush is "slightly tilted" and thus only encompassing a small angle will not

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touch the inner wall of the receptacle when in the assembled condition, further Anakama discloses that the applicator bristles can be brought out smoothly, without dragging or catching on anything at all. Anakama discloses the claimed invention except for the brush comprising a twisted wire core and the specific angle the bristle carrying portion makes relative to the longitudinal axis of the rod.

Gueret discloses that it is old and well known in the art to make mascara brushes with a twisted wire core. Gueret further discloses various mascara brushes having non-circular cross sections; longitudinal ribs; plane surfaces; concave surfaces; constant cross sections; varying cross sections; and cross sections that vary in size, and having an envelope surface having a non-circular cross-section at at least one point along the bristle carrying portion. Because both Anakama and Gueret disclose application brushes, it would have been obvious to one skilled in the art to substitute the twisted wire core brush of Gueret for the brush of Anakama in order to achieve the predictable result of manufacturing an applicator brush (*KSR International v. Teleflex Inc.*, 82 USPQ2d 1385 (2007)).

Further Anakama discloses that the angle is around 30 degrees. Anderson teaches a mascara application device that teaches an angle from 0 to 60 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the angle of Anakama to be at a range from 0 to 60 degrees in order to accommodate different users. Further it would have been further obvious to one having ordinary skill in the art at the time the invention was made to have the bristle carrying portion make an angle of less than 20 degrees relative to the longitudinal axis

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of the rod, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claims 2-4, 12-15, 19-26, it would have been obvious to one skilled in the art to form the brush of Anakama with the bristles forming an envelope having non-circular cross sections; longitudinal ribs; plane surfaces; concave surfaces; constant cross sections; varying cross sections; and cross sections that vary in size, but not shape in view of Gueret in order to obtain a make-up which is full-bodied, regular, elongated and curls.

Regarding claims 16-18, it would have been obvious to one of ordinary skill to make the core of twisted wire having either a right or left hand pitch, as it is old and well known in the art to make mascara brushes with a twisted wire core having either a right or left hand pitch.

Regarding claim 35, it appears as though the wiper member would have a circular cross-section since the rod has a circular-cross section, however, it would have been an obvious matter of design choice to have the wiper be of a circular-cross since applicant has not disclosed that the wiper of any other cross-section solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any cross-sectional wiper.

4. Claims 27, 28, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anakama (Japanese Patent No. 55-136409) in view of Gueret (US 5,918,994), Anderson (US 3,343,551), and Gueret (US 5,462,798).

Anakama discloses a device comprising a rod 2 having a brush 3 affixed to one end with a core and bristle carrying portion. The bristle carrying portion forms an angle of greater than zero degrees relative to the longitudinal axis of the rod. The device further includes a receptacle adapted to receive the rod and brush. As noted in the claims the brush is "slightly tilted" and thus only encompassing a small angle will not touch the inner wall of the receptacle when in the assembled condition, further Anakama discloses that the applicator bristles can be brought out smoothly, without dragging or catching on anything at all. Anakama discloses the claimed invention except for the brush comprising a twisted wire core and the specific angle the bristle carrying portion makes relative to the longitudinal axis of the rod.

Gueret discloses that it is old and well known in the art to make mascara brushes with a twisted wire core. Gueret further discloses various mascara brushes having non-circular cross sections; longitudinal ribs; plane surfaces; concave surfaces; constant cross sections; varying cross sections; and cross sections that vary in size, and having an envelope surface having a non-circular cross-section at at least one point along the bristle carrying portion. Because both Anakama and Gueret disclose application brushes, it would have been obvious to one skilled in the art to substitute the twisted wire core brush of Gueret for the brush of Anakama in order to achieve the predictable result of manufacturing an applicator brush (*KSR International v. Teleflex Inc.*, 82 USPQ2d 1385 (2007)).

Further Anakama discloses that the angle is around 30 degrees. Anderson teaches a mascara application device that teaches an angle from 0 to 60 degrees. It

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would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the angle of Anakama to be at a range from 0 to 60 degrees in order to accommodate different users. Further it would have been further obvious to one having ordinary skill in the art at the time the invention was made to have the bristle carrying portion be made at an angle of greater than 5 degrees and less than about 10 degrees relative to the longitudinal axis of the rod, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Anakama does not disclose a compound configured to cause a modification to sliding resistance of the bristles. Gueret teaches compound configured to cause a modification to sliding resistance of the bristles (column 2, Example 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the bristles of Anakama with a sliding component as taught by Gueret in order to provide a sliding resistance to the bristles.

Response to Amendment

5. The declaration under 37 CFR 1.132 filed February 24, 2009 is insufficient to overcome the rejection of claims 1, 3-32, and 34-36 based upon the rejection above because:

6. It refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the

objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

7. Further in order for applicant to establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. In re Hill, 284 F.2d 955, 128 USPQ 197 (CCPA 1960). Applicant did not show "a sufficient number of tests".

Response to Arguments

8. Applicant's arguments filed February 24, 2009 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel R. Steitz whose telephone number is (571)272-1917. The examiner can normally be reached on Monday-Friday 7:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robyn Doan/
Primary Examiner, Art Unit 3732

/Rachel Running Steitz/
Examiner
Art Unit 3732

4/15/2009